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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/763,189 | 01/26/2004 | David Bieber | 01876.0039 | 6440 |
| 22852 | 7590 | 09/08/2006 | EXAMINER | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | SILBERMANN, JOANNE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3611 | |

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/763,189 | Applicant(s) BIEBER, DAVID | |
| | Examiner Joanne Silbermann | Art Unit 3611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-8, 14, 18-21, 27, 35, 37, 39-41, 45, 52-54, 56, 58, 73, 76, 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 2-4,9-13,15-17,22-26,28-34,36,38,42-44,46-51,55,57,59-72,74,75 and 78.

Election/Restrictions

1. Applicant's election of Group II in the reply filed on June 2, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 2-4, 9-13, 15-17, 22-26, 28-34, 36, 38, 42-44, 46-51, 55, 57, 59-72, 74, 75, and 78 (as stated by Applicant) stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 2, 2006.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 45 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by Goserud, US #5,461,810.
5. Goserud discloses display sleeve 10 having front and back sides and open end 20. Information sheet 12 is retained therein. The open end is configured to receive a portion of an article. The sleeve is bowed so as to retain the sheet therein.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goserud, US #5,461,810.

8. Goserud teaches display sleeve 10 comprising at least one open end 20 (Figure 1), front side 13 (Figure 3), border 18 forming a window on the front side, back side 14, and advertising sheet 12. The front and back sides are flexible (column 2 line 60). Sheet 12 is removably disposed within the sleeve and may be exchanged.

9. Goserud does not specifically describe the indicia as being related to advertising, however where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. MPEP 2112.01 III. Applicant's printed matter does not provide any new and unobvious functional relationship between the printed matter and the substrate.

10. Claims 5-8, 52, 53 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goserud as applied to claim 1 above, and further in view of Wong, US #6,597,934.

Art Unit: 3611

11. Goserud also teaches inner sleeve 11 between the front and back sides of the display sleeve, but does not describe this sleeve as being transparent. Wong teaches a display including display sleeve (2,3) and transparent sleeve 6, 7 (Figures 3 and 4). It would have been obvious to a person having ordinary skill in the art to make the inner sleeve of Goserud transparent if no decorative material is desired to be shown.

12. Goserud does not particularly teach the size of the transparent sheet or the information sheet as being 8 ½ inches by 11 inches. It would have been an obvious matter of design choice to make the sheet and sleeve of Goserud this size since such a modification would have involved a mere change in the size of these components. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Also, it would have been obvious to one of ordinary skill to make the display larger or smaller (depending on its intended use) so that it may be easily and conveniently seen by a viewer.

13. The inner sleeve of Goserud is attached to the display sleeve by means of a contact force, as described in column 3 lines 16-34.

14. Claims 14, 27, 54, 58 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goserud as applied to claims 1 and 45 above, and further in view of Geiser et al. US #Des. 419,303.

15. Goserud does not teach attaching the display to an article of merchandise, however such displays are well known in the art, as shown by Geiser. Geiser teaches a display sleeve attached to an article of merchandise (Figure 2). It would have been

Art Unit: 3611

obvious to one of ordinary skill in the art to attach a display sleeve (as in Goserud) to an article of merchandise, as taught by Geiser, so as to provide personalization or decoration to the article. Such decoration may induce a customer to purchase such an article.

16. Regarding the method steps, Geiser teaches an article of merchandise having a display sheet thereon, and Goserud teaches the elements of the display, as discussed above. The method steps of displaying and providing would have been obvious to a person having ordinary skill in the art given the disclosures of Goserud and Geiser.

17. Regarding claim 58, the display is wrapped around the article of merchandise (Geiser, Figure 2).

18. Claims 18-21, 35 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goserud and Geiser et al. as applied to claim 14 above, and further in view of Wong.

19. It would have been obvious to include the transparent sleeve of Wong in the display of Goserud/Geiser (and to change the size thereof) for the same reasons as discussed above.

20. Claim 35 does not appear to contain any further method steps.

21. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goserud in view of Duffney, US #6,617,005.

Art Unit: 3611

22. Goserud, as described with respect to claim 1, does not teach printed matter on the border, however this is well known in the art, as shown by Duffney. Duffney teaches a border around a window including decorative effects 20. It would have been obvious to one of ordinary skill to provide such decoration on the border of the display of Goserud so as to provide a more aesthetically pleasing display.

23. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goserud and Duffney as applied to claim 37 above, and further in view of Wong.

24. It would have been obvious to one of ordinary skill to utilize the transparent sleeve of Wong in the display of Goserud/Duffney (and to change the size thereof) for the same reasons as described above.

Response to Arguments

25. Applicant's arguments, see response, filed July 27, 2005, with respect to the rejection(s) of the claims have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.


Applicant's arguments regarding use of the word "configured" have been considered, however the article of merchandise is not part of the claimed invention in many of these claims. If the merchandise is intended to be attached to the display, it is suggested that such language be included in these claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joanne Silbermann
Primary Examiner
Art Unit 3611

js
03 September 2006